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EXAMINER

PWU, JEFFREY C

ART UNIT PAPER NUMBER

2143

DATE MAILED: 06/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/867,532

Applicant(s)

AISO, TOMOHIRO

Examiner

Jeffrey C. Pwu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) 16-24, 35-41, and 52-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 8-17, 25-34 and 54 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/01/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The disclosure lacks clear written description in the description of both a designator and a detector. Nowhere in the specification teaches a designator or a detector. It is unclear where is the detector being connected to in a network detecting access status and/or what is a designator and how to designate insertion of an advertisement.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 8, 11-12, 14, 25, 28-29, 31, 42, 45-46, 48 and 54 are rejected under 35 U.S.C. 102(e) as being anticipated by Ballard (U.S. 6,182,050).

With respect to claim 8, Ballard teaches a server operation support apparatus supporting an operation of a server to which a plurality of client computers are connected through a network, said server allowing insertion of an advertisement that can be viewed by said plurality of client computers [Ballard -- Abstract], said server operation support apparatus comprising: storage for storing in advance information indicating an advertiser [Ballard -Col. 8 lines 44-56 -Advertisement information is stored electronically]; a detector connected to said network for detecting an access status of a client computer to said server [Ballard -- Col. 7 lines 14-31 and lines 50-65 - Affinity rankings are monitored as one criteria to determine which advertisements are to be displayed and when. Affinity rankings include an access status, i.e. user's only history/habits, namely what sites they have visited and how often, etc.]; a designator connected to said storage and said detector for designating insertion of an advertisement to said server according to information indicating an advertiser stored in said storage, when said access status detected by said detector satisfies a predetermined condition [Ballard -- Figure 3, Col. 10 lines 1-25 and Col. 11 lines 29-61 - Advertisements are selected for insertion when the access status, i.e. affinity ranking, satisfies a given ranking condition, i.e. some predetermined level].

With respect to claim 11, Ballard further teaches the apparatus further comprising a communication system for communicating with said advertiser to receive advertisement data from said advertiser, wherein said designator designates insertion of an advertisement realized by said received advertisement data to said server [Ballard -- Col. 8 lines 44-56 - Advertisers submit advertisement data to Advertising Service Provider (ASP) along with target criteria for when to insert the data].

With respect to claim 12, Ballard further teaches wherein said designator comprises a transmitter insertion query information including insertion confirmation information confirming whether an advertisement is to be posted or not to the advertiser whose information is stored in said storage, when said access status detected by said detector satisfies a predetermined condition, and a system for suppressing an operation by said designation means in response to not receiving an insertion request corresponding to said insertion query information within a predetermined period [Ballard -- Col. 8 lines 7-21 and Col. 10 lines 26-41 - Report information is transmitted to ASP and then to advertisers to provide them with information concerning their advertisements and the current campaign, such as the dates and times of display for a particular ad, etc.].

With respect to claim 14, Ballard further teaches wherein said transmitter for transmitting insertion query information transmits said insertion query information a plurality of advertisers [Ballard - Col. 8 lines 7-21 and Col. 10 lines 26-41 - Report

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information is transmitted to ASP and then to advertisers to provide them with information concerning their advertisements and the current campaign, such as the dates and times of display for a particular ad, etc.], wherein said predetermined condition includes a condition determined for each said advertiser [Ballard -- Col. 7 lines 14-31 and Col. 10 lines 58-67 - Predetermined conditions can consist of multiple conditions, such as affinity ranking, number of users during a time period, time slot, number of end users to receive advertisement, etc.].

With respect to claims 25, 28-29 and 31, these are apparatus circuit claims similar to the apparatus claimed in claims 8, 11-12 and 14 above. They have similar limitations; therefore, claims 25, 28-29 and 31 are rejected under the same rationale.

With respect to claims 42, 45-46 and 48, these are method claims similar to the apparatus claimed in claims 8, 11-12 and 14 above. They have similar limitations; therefore, claims 42, 45-46 and 48 are rejected under the same rationale.

With respect to claim 54, Ballard teaches a computer-readable recording medium recorded with a program [Ballard -- Col. 5 lines 65-67 - Col. 6 lines 1-23]. The remaining limitations in claim 54 are similar to the limitations claimed in claim 8. Therefore, they are rejected under the same rationale.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 9, 26 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ballard (U.S. 6,182,050).

Regarding claim 9, Ballard teaches the invention substantially as claimed, including wherein said predetermined condition includes a condition that a value calculated is at least a predetermined value [Ballard -- Col. 11 lines 39-43 - Affinity ranking, which contains access status such as online history/habits, selects ads based upon whether the ranking is above a prescribed or programmable threshold level]. Although not explicitly taught, it would have been obvious to a person of ordinary skill in the art that keeping track of a user's online viewing and access habits/history would include the number of access to a given site/server in order to track the user's habits. It would have been obvious to include this tracking statistic in order to provide better advertising results to both advertisers and users, such that advertisers would be targeting clients which have an interest in some subject/site because they access the site frequently, and users would receive advertisements which are more likely to interest them rather than random advertisements.

Regarding claim 26, this is an apparatus circuit claim similar to the apparatus claimed in claim 9 above. It has similar limitations; therefore, claim 26 is rejected under the same rationale.

Regarding claim 43, this is a method claim similar to the apparatus claimed in claim 9 above. It has similar limitations; therefore, claim 43 is rejected under the same rationale.

7. Claims 10, 15-16, 27, 32-33, 44 and 49-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ballard (U.S. 6,182,050) in view of Gupta et al. (U.S. 6,487,538).

Regarding claim 10, Ballard teaches the invention substantially as claimed, as aforementioned in claim 8 above, but fails to explicitly teach wherein the advertising fee is set according to the access status. Gupta, however, discloses an advertising system which advertisers pay an advertisement fee based on the number of times different users access a given site and see the add, i.e. a site hit [Gupta -- Col. 4 lines 26-36 and Col. 5 lines 66-67 - Col. 6 lines 1-9]. Both Ballard and Gupta are concerned with providing targeted advertisements to users over the Internet. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the advertising fee based upon number of accesses to a given site/server, as taught by Gupta into the invention of Ballard, in order to provide a fair and cost effective solution to advertisers by charging fees dependent upon how many

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viewers actually view a site thereby allowing advertisers to more effectively place advertisements pay fees commensurate with what the campaign was actually worth.

Regarding claim 15, Ballard teaches the invention substantially as claimed, as aforementioned in claim 14 above, but fails to explicitly teach wherein the advertising fee is set according to the access status for each advertiser.

Gupta, however, discloses an advertising system which advertisers pay an advertisement fee based on the number of times different users access a given site and see the add, i.e. a site hit [Gupta - Col. 4 lines 26-36 and Col. 5 lines 66-67 - Col. 6 lines 1-9]. It would have been obvious to a person of ordinary skill in the art that this fee would differ based upon the advertiser's advertisement, i.e. size, campaign outreach, etc.; thereby providing customized ad prices to users which require varying levels of advertising. Both Ballard and Gupta are concerned with providing targeted advertisements to users over the Internet. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the advertising fee based upon number of accesses to a given site/server for each advertiser, as taught by Gupta into the invention of Ballard, in order to provide a fair and cost effective solution to advertisers by charging fees dependent upon how many viewers actually view a site thereby allowing advertisers to more effectively place advertisements pay fees commensurate with what the campaign was actually worth.

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Regarding claim 16, Ballard-Gupta teach the invention substantially as claimed, as aforementioned in claim 15 above, including wherein said designation means comprises means for designating insertion of said advertisement to said server in a descending order of said advertising fee [Gupta -- Col. 12 lines 8-50 - Most expensive ads are shown first and then rotated with other ads which would obviously be less expensive, thereby having a descending order].

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate displaying ads in a descending order of ad fee in order to allow the advertisers to find an optimum balance for maximizing revenue brought in from advertisements and minimizing the cost of advertisements, thus found by placing ads in a descending order.

Regarding claims 27 and 32-33, these are apparatus circuit claims corresponding to the apparatus claimed in claims 10 and 15-16 above. They have similar limitations; therefore, claims 27 and 32-33 are rejected under the same rationale.

Regarding claims 44 and 49-50, these are method claims corresponding to the apparatus claimed in claims 10 and 15-16 above. They have similar limitations; therefore, claims 244 and 49-50 are rejected under the same rationale.

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8. Claims 13, 30 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ballard (U.S. 6,182,050) in view of Matsumoto et al. (U.S. 6,763,334).

Regarding claim 13, Ballard teaches the invention substantially as claimed, as aforementioned in claim 12 above, but fails to explicitly teach wherein said insertion query information includes access information indicating an access status.

Matsumoto, however, discloses a system for arranging the delivery of advertisements over the Internet which includes generating a statistical report containing access information regarding a particular advertising campaign [Matsumoto -- Figures 7-9, Col. 10 lines 31-67 - Col. 11 lines 1-671. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the inclusion of access statistics into a report, as taught by Matsumoto into the invention of Ballard, in order to allow the advertiser to better evaluate the effectiveness of an ad campaign [Matsumoto -- Col. 11 lines 16-191.

Regarding claim 30, this is an apparatus circuit claim similar to the apparatus claimed in claim 13 above. It has similar limitations; therefore, claim 30 is rejected under the same rationale.

Regarding claim 47, this is a method claim similar to the apparatus claimed in claim 13 above. It has similar limitations; therefore, claim 47 is rejected under the same rationale.

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9. Claims 17, 34 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ballard (U.S. 6,182,050) and Gupta et al. (U.S. 6,487,538); as applied to claims 15, 32 and 49 above respectively, in view of Matsumoto et al. (U.S. 6,763,334).

Regarding claim 17, Ballard-Gupta teach the invention substantially as claimed, as .
aforementioned in claim 15 above, but fail to explicitly teach wherein said insertion information includes charge information indicating the advertising fee set. Matsumoto, however, discloses an advertisement system which indicates the cost per response of the advertisement and the total projected sales which are expected from the campaign [Matsumoto -- Figure 4 and Col. 6 lines 22-391. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the charge information/fee of the advertisement, as taught by Matsumoto into the invention of Ballard-Gupta, in order to provide a user-friendly view of the information associated with an ad campaign which allows the advertiser/affiliate to determine the cost/revenue and other financial information about the campaign.

Regarding claim 34 this is an apparatus circuit claim similar to the apparatus claimed in claim 17 above. It has similar limitations; therefore, claim 34 is rejected under the same rationale.

Regarding claim 51, this is a method claim similar to the apparatus claimed in claim 17 above. It has similar limitations; therefore, claim 51 is rejected under the same rationale.

Response to Arguments

10. Applicant argues that applicant's claims are directed to a server level ad delivery system that uses information access to the server by a plurality of client computers to determine if a predetermined access condition is satisfied prior to inserting an advertisement in the server for viewing by a plurality of client computers.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "determine if a predetermined access condition is satisfied prior to inserting an advertisement in the server for viewing by a plurality of client computers") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The body of the claims of claim 8, 25, 42, and 54 do not show a server level ad delivery system that uses information access to the server by a plurality of client computers to determining if a predetermined access condition is satisfied prior to inserting an advertisement in the server for viewing by a plurality of client computers.

Ballard discloses a system and method comprising:

- storage for storing in advance information indicating an advertiser; [Ballard -Col. 8 lines 44-56 -Advertisement information is stored electronically; "computer end users subscribes to the advertising service provider" – col.1, line 68-col.2, line 1]

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- a detector connected to said network for detecting an access status of a client computer to said server; [Ballard -- Col. 7 lines 14-31 and lines 50-65 - Affinity rankings are monitored as one criteria to determine which advertisements are to be displayed and when. Affinity rankings include an access status, i.e. user's only history/habits, namely what sites they have visited and how often, etc.; (14, 52)];
- a designator connected to said storage and said detector for designating insertion of an advertisement to said server according to information indicating an advertiser stored in said storage, when said access status detected by said detector satisfies a predetermined condition. [Ballard -- Figure 3, Col. 10 lines 1-25 and Col. 11 lines 29-61 - Advertisements are selected for insertion when the access status, i.e. affinity ranking, satisfies a given ranking condition, i.e. some predetermined level]

11. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). Applicant's amendment of claim 8 necessitated the new ground(s) of 112 rejection presented in this Office action.

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey C. Pwu whose telephone number is 571-272-6798.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



6/4/2005

JEFFREY PWU
PRIMARY EXAMINER